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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,058	10/30/2003	Patrick Ward	40526-00035USPT	8125
7590	06/28/2005			EXAMINER CHOI, JACOB Y
Alan R. Thiele Strasburger and Price LLP Suite 4400 901 Main Street Dallas, TX 75202			ART UNIT 2875	PAPER NUMBER
DATE MAILED: 06/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

HA

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/697,058	WARD, PATRICK	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jacob Y. Choi	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 October 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 30 October 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 21, 40, and 111. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a plurality of individual light sources, a plurality of individual light fixtures must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3-7, and 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Rippel et al. (USPN 6,632,006).

Regarding claim 1, Rippel et al. discloses a mounting for a light source (6), the mounting constructed and arranged to position the light source near the plane of a ceiling (20) or a floor adjoining the wall and to direct the light emitted from the light source at an acute angle (claims 6 and 17) to a plane perpendicular to the plane of the ceiling (20) or the floor and away from the wall, an arcuate kick reflector (columns 4, lines 25-55) constructed and arranged to reflect the light emitted from the light source and direct the light emitted from the light source toward the wall, whereby the combination of the mounting of the light source and the reflection of the arcuate kick reflector provides substantially uniform illumination of the wall (column 3, lines 1-10).

Note: claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 644 (CCPA 1974).

Regarding claim 3 and 9, Rippel et al. discloses the kick reflector (columns 4, lines 25-55) includes a reflective surface constructed and arranged to diffuse the light emitted by the light source.

Regarding claim 4 and 10, Rippel et al. discloses a light-diffusing lens (66) between the light source and the kick reflector.

Regarding claim 5, Rippel et al. discloses a trim ring assembly connected to the adjustable mounting (column 5, lines 15-25).

Regarding claim 6, Rippel et al. discloses a housing (40) connected to the trim ring (41) assembly.

Regarding claim 7, Rippel et al. discloses a trim ring assembly, a housing (40) connected to the trim ring (41, 42) assembly, the housing constructed and arranged to provide a mounting for a light source (6), a light source positioning ring connected to the trim ring and positioned within the housing, the light source mounting ring including a mounting surface positioned in a plane which is at an acute angle (claims 6 and 17) with respect to the plane of the trim ring to direct the light emitted from the light source away from the wall, a substantially arcuate kick reflector constructed and arranged to be positioned within the light source positioning ring to direct the light rays emitted from the light source toward the wall, whereby substantially uniform illumination of an area on a wall is provided (column 3, lines 1-10).

5. Claims 1, 3, 5-7, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Ng et al. (USPN 6,350,047).

Regarding claim 1, Ng et al. discloses a mounting for a light source (46), the mounting constructed and arranged to position the light source (46) near the plane of a ceiling (24, 26) or a floor adjoining the wall and to direct the light emitted from the light source (46) at an acute angle (Figure 5) to a plane perpendicular to the plane of the ceiling or the floor and away from the wall, an arcuate kick (Figure 4a) reflector constructed and arranged to reflect the light emitted from the light source (46) and direct the light emitted from the light source toward the wall, whereby the combination of the mounting of the light source (46) and the reflection of the arcuate kick reflector (Figure 4a) provides substantially uniform illumination of the wall.

Regarding claim 3 and 9, Ng et al. discloses the kick reflector (Figure 4a) includes a reflective surface constructed and arranged to diffuse the light emitted by the light source.

Regarding claim 5, Ng et al. discloses a trim ring assembly connected to the adjustable mounting (Figures 7A-7C).

Regarding claim 6, Ng et al. discloses a housing (10) connected to the trim ring (22) assembly.

Regarding claim 7, Ng et al. discloses a trim ring assembly, a housing (34) connected to the trim ring (22) assembly, the housing constructed and arranged to provide a mounting for a light source (46), a light source (46) positioning ring connected to the trim ring (22) and positioned within the housing (34), the light source (46) mounting ring including a mounting surface positioned in a plane which is at an acute angle (Figure 4a) with respect to the plane of the trim ring to direct the light emitted from the light source away from the wall, a substantially arcuate kick reflector (Figure 4a) constructed and arranged to be positioned within the light source (46) positioning ring to direct the light rays emitted from the light source (46) toward the wall, whereby substantially uniform illumination of an area on a wall is provided.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 2, 8, and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rippel et al. (USPN 6,632,006).

Regarding claim 2 and 8, Rippel et al. discloses a kick reflector 45 to kick a portion of the light emitted outward from the fixture at an angle to illuminate a nearby wall close to the ceiling

Rippel et al. failed to disclose the specifics of the acute angle is about 1 degree to about 5 degrees.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify workable ranges of the acute angle to illuminate the nearby wall from the ceiling, where the distance of the light from the wall would most likely determine the correct acute angle for the uniform illumination of the wall, and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claims 11-17, Rippel et al. discloses the structural limitations of the applicant's claimed invention, explained above.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify or claim of a use of a light fixture where Ripple et al. clearly provides the claimed structure that would perform the same.

It has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961).

Regarding claims 18-20, Rippel et al. discloses a light source (6), a light fixtures, an adjustable mounting for positioning the individual light source at an acute angle (claims 6 and 17) with respect to a plane perpendicular to either the ceiling (20) or the floor adjoining the wall to direct the light from the light source away fro the wall, a housing for positioning the adjustable mounting, a trim ring assembly connected to the housing, a substantially arcuate kick reflector (columns 4, lines 25-55) for directing light emitted form the light source to the wall, whereby the combination of the positioning of the light source and the substantially arcuate kick reflector (columns 4, lines 25-55) within the plurality of individual mounted light fixtures provides a substantially uniform level of illumination on the wall, a substantially arcuate kick reflector (columns 4, lines 25-55) positioned within the housing to reflect light from the light source toward a wall, the substantially arcuate kick reflector (columns 4, lines 25-55) including a curved planar interior reflecting surface, the substantially arcuate shape of the kick reflector (columns 4, lines 25-55) is selected form a group including, substantially circular, substantially elliptical, and substantially oval.

Rippel et al. discloses the claimed invention except the prior art does not clearly show a plurality of individual light fixtures.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the plurality of light fixtures of Rippel et al. to the ceiling for even greater illumination through out the room or the wall, since it has been held that mere duplication of the essential working parts of the device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

8. Claims 2, 8, 11-15, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng et al. (USPN 6,350,047).

Regarding claim 2 and 8, Ng et al. discloses a kick reflector portion of the light emitted outward from the fixture at an angle to illuminate a nearby wall close to the ceiling

Ng et al. failed to disclose the specifics of the acute angle is about 1 degree to about 5 degrees.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify workable ranges of the acute angle to illuminate the nearby wall from the ceiling, where the distance of the light from the wall would most likely determine the correct acute angle for the uniform illumination of the wall, and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claims 11-15 and 17, Ng et al. discloses the structural limitations of the applicant's claimed invention, explained above.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify or claim of a use of a light fixture where Ripple et al. clearly provides the claimed structure that would perform the same.

It has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961).

Regarding claims 18-20, Ng et al. discloses a light source (46), a light fixtures, an adjustable mounting for positioning the individual light source at an acute angle (Figure 5) with respect to a plane perpendicular to either the ceiling or the floor adjoining the wall to direct the light from the light source away fro the wall, a housing for positioning the adjustable mounting, a trim ring (22) assembly connected to the housing, a substantially arcuate kick reflector (Figure 4a) for directing light emitted form the light source to the wall, whereby the combination of the positioning of the light source and the substantially arcuate kick reflector (Figure 4a) within the plurality of individual mounted light fixtures provides a substantially uniform level of illumination on the wall, a substantially arcuate kick reflector (Figure 4a) positioned within the housing to reflect light from the light source (46) toward a wall, the substantially arcuate kick reflector (Figure 4a) including a curved planar interior reflecting surface, the substantially arcuate

shape of the kick reflector (Figure 4a) is selected from a group including, substantially circular, substantially elliptical, and substantially oval.

Ng et al. discloses the claimed invention except the prior art does not clearly show a plurality of individual light fixtures.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the plurality of light fixtures of Ng et al. to the ceiling for even greater illumination throughout the room or the wall, since it has been held that mere duplication of the essential working parts of the device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fischer et al. (USPN 6,802,627) – directional luminaire

Ng (USPN 6,779,908) – adjustable downlight lighting fixture

Wang et al. (USPN 6,755,559) – luminaire with adjustable lamp orientation

NG (USPN 6,655,813) – multi-function luminaire

Schubert et al. (USPN 6,431,723) – recessed lighting fixture

Cummings et al. (USPN 6,375,338) – modular lighting fixture

Doubek et al. (USPN 6,082,878) – fully rotatable recessed light fixture with movable stop and adjustable length bar hanger

Doubeck et al. (USPN 5,951,151) – lamp assembly for a recessed ceiling fixture

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Demshki, Jr. et al. (USPN 5,823,664) – recessed lighting fixture

Chan et al. (USPN 5,562,343) – multifunctional recessed lighting fixture

Chan et al. (USPN 5,457,617) – sloped recessed lighting fixture

Conti (USPN 4,623,956) – recessed adjustable lighting fixture

Kelsall (USPN 4,232,361) – adjustable light fixture

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y. Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JC

**JOHN ANTHONY WARD  
PRIMARY EXAMINER**